

REMARKS/ARGUMENTS

The foregoing amendments in the claims are of formal nature, and do not add new matter. With this amendment, Claims 63 and 78 have been amended to clarify what Applicants have always regarded as their invention. Claims 63, 66, 68-70 and 74-84 are pending after entry of the instant amendment.

Applicants expressly reserve the right to pursue any canceled matter in subsequent continuation, divisional or continuation-in-part applications.

I. Priority

Applicants thank the Examiner for granting the priority of the instant application to February 11, 2000.

Applicants further note that the PRO274 polypeptide sequence and its encoding nucleic acid sequence were first disclosed in the U.S. Provisional Application Serial No. 60/082,700, filed on April 22, 1998, priority to which has been claimed in this application.

II. Claim Objections

Claim 78 is objected to because of the recitation of "nucleotides" instead of "nucleotide" on line 2 of the claim. Applicants thank the Examiner for pointing out this grammatical error, which has been corrected by amendment herein.

Withdrawal of the objection to Claim 78 is therefore respectfully requested.

III. Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 63, 66, 68-70 and 74-84 are rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite. In particular, the Examiner states that Claims 63, 68-70 and 74-77 are indefinite because there is no SEQ ID number recited in Claim 63, part (c). Applicants thank the Examiner for pointing out this typographical error, which has been corrected by amendment herein.

The Examiner further asserts that Claims 78-84 are indefinite because in line 2 of Claim 78 it is allegedly unclear whether the "complement" refers to the complement of the fragment or the entire sequence of SEQ ID NO:6.

Without acquiescing to the Examiner's position in the current rejections, Applicants have amended Claim 78 to recite, "An isolated nucleic acid molecule consisting of an at least 20 nucleotide fragment of the nucleic acid sequence of SEQ ID NO:6, or a complement of said fragment...." Accordingly, Applicants submit that the meaning of the claims is clear, and that one or ordinary skill in the art would understand what is encompassed within the claimed subject matter.

Withdrawal of the rejections under 35 U.S.C. §112, second paragraph is therefore respectfully requested.

IV. Claim Rejections – 35 U.S.C. §102(b)

Claims 78-84 are rejected under 35 U.S.C. §102(e) as being anticipated by Komatsoulis *et al.*, U.S. Patent No. 6,476,195, filing date January 24, 2000. The earliest claimed priority dated for Komatsoulis *et al.* is July 30, 1998. The Examiner asserts that Komatsoulis *et al.* disclose a nucleic acid molecule that is 99.8% identical to nucleotides 595-2943 of SEQ ID NO:6, and comprises regions of greater than 100 contiguous nucleotides that are identical to SEQ ID NO:6.

Applicants have claimed priority to U.S. Provisional Application Serial No. 60/082,700, filed on April 22, 1998. The present application is entitled to the priority date of April 22, 1998, which precedes, by over three months, the earliest possible priority date of Komatsoulis *et al.* (July 30, 1998). Accordingly, Komatsoulis *et al.* is not prior art against the present application and Claims 78-84 are patentable.

In support, Applicants respectfully submit a Declaration under 37 C.F.R. §1.131 by Dr. Goddard, Dr. Godowski, Dr. Gurney, Ms. Roy and Dr. Wood that establishes that Applicants had cloned and sequenced SEQ ID NO:6, and determined the homology of the encoded polypeptide to 7 transmembrane segment receptor proteins and the Fn54 protein, before the prior art date of July 30, 1998. The consideration of the Declaration is respectfully requested.

Applicants respectfully submit that an executed copy of the Declaration will be submitted to the Examiner shortly.

U.S. Provisional Application Serial No. 60/082,700 Simply Needs to Disclose What is Disclosed in the Cited Reference to Support the Priority Claim

Applicants respectfully submit that in order to overcome the 35 U.S.C. §102(e) rejection over Komatsoulis *et al.*, the Declaration by Dr. Goddard, Dr. Godowski, Dr. Gurney, Ms. Roy and Dr. Wood (“Declaration”) simply needs to provide a disclosure commensurate in scope with the disclosure in the prior art document by Komatsoulis *et al.* to support the priority claim.

In order to remove a reference as a prior art, “[i]t is sufficient if [the affidavit under Patent Office Rule 131] shows that as much of the claimed invention as is taught in the reference has been reduced to practice by the [patentee] prior to the date of the reference.” *In re Stempel*, 241 F.2d 755, 757 (1957). In *In re Stempel*, the patent applicant (Stempel) had claims directed to both (i) a particular genus of chemical compounds (the “generic” claim) and (ii) a single species of chemical compound that was encompassed within that genus (the “species” claim). In support of a rejection under 35 U.S.C. §102, the examiner cited against the application a prior art reference that disclosed the exact chemical compound recited in the “species” claim. In response to the rejection, the patent applicant filed a declaration under 37 C.F.R. §1.131 demonstrating that he had made that specific chemical compound prior to the effective date of the cited prior art reference. The Court found the applicant’s 37 C.F.R. §1.131 declaration effective for swearing behind the cited reference for purposes of both the “species” claim and the “genus” claim. Specifically, the Court stated in support of its decision that “all the applicant can be required to show is priority with respect to so much of the claimed invention as the reference happens to show. When he has done that he has disposed of the reference.” *Id.* at 759.

Furthermore, the Examiner is respectfully directed to *In re Moore*, 170 USPQ 260 (CCPA 1971), where the holding in *In re Stempel* was affirmed. In *In re Moore*, the patent applicant claimed a particular chemical compound in his patent application and the examiner cited against the applicant a prior art reference under 35 U.S.C. §102 rejection which disclosed the compound but did not disclose any specific utility for the compound. The patent applicant filed a declaration under 37 C.F.R. §1.131 demonstrating that he had made the claimed compound before the effective date of the cited prior art reference, even though he had not yet established a utility for that compound.

On appeal, the Court indicated that the 131 declaration filed by the patent applicant was sufficient to remove the cited reference. The Court relied on the established “Stempel Doctrine” to support its decision, stating:

An applicant need not be required to show [in a declaration under 37 C.F.R. §1.131] any more acts with regard to the subject matter claimed that can be carried out by one of ordinary skill in the pertinent art following the description contained in the reference ... the determination of a practical utility when one is not obvious need not have been accomplished prior to the date of a reference unless the reference also teaches how to use the compound it describes.

In re Moore, 170 USPQ at 267 (emphasis added).

Thus, *In re Moore* confirmed the holding in *In re Stempel* which states that in order to effectively remove a cited reference with a declaration under 37 C.F.R. §1.131, **an applicant need only show that portion of his or her claimed invention that appears in the cited reference.**

As the Examiner noted, Komatsoulis *et al.* discloses a nucleic acid sequence, SEQ ID NO:44, or Gene No. 34, fragments of which overlap with fragments of SEQ ID NO:6. Komatsoulis *et al.* discloses that the protein product of SEQ ID NO:44 shares homology with mitogen-induced prostate carcinoma protein (mouse). Although Komatsoulis *et al.* includes general statements regarding possible uses of the sequence, no specific examples or experimental data are provided regarding the use of SEQ ID NO:44, or fragments thereof. Nor are any particular fragments of SEQ ID NO:44 specifically identified as being useful as primers or probes.

Applicants respectfully submit that since Komatsoulis *et al.* only discloses a polypeptide sequence, its encoding nucleic acid sequence, and a sequence homology, without any disclosure to support utility for fragments of the nucleic acid sequence, the Declaration simply needs to show possession of the polypeptide sequence and its encoding polynucleotide sequence as disclosed in Komatsoulis *et al.* and a sequence homology in order to overcome the 35 U.S.C. §102 rejection.

Applicants respectfully submit that U.S. Provisional Application Serial No. 60/082,700 filed on April 22, 1998, provides the nucleic acid and amino acid sequences of the PRO274 polypeptide.

The Declaration clearly states that U.S. Provisional Application Serial No. 60/082,700 filed on April 22, 1998 discloses sequences designated as SEQ ID NO:1 and SEQ ID NO:3, which are identical to SEQ ID NO:6 and SEQ ID NO: 7, respectively, of the above-identified application. U.S. Provisional Application Serial No. 60/082,700 further discloses that the full length PRO274 polypeptide (SEQ ID NO:3) has significant homology to 7 transmembrane segment receptor proteins and the Fn54 protein.

In addition, U.S. Provisional Application Serial No. 60/082,700 further discloses numerous fragments of the nucleic acid sequence of SEQ ID NO:1, corresponding to SEQ ID NO:6 of the above-identified application, as shown in Figures 3 and 4. One of skill in the art would have reasonably understood at the filing date of U.S. Provisional Application Serial No. 60/082,700 that such fragments would be useful as primers or probes.

Accordingly, Applicants respectfully submit that the disclosures are commensurate in scope and that U.S. Provisional Application Serial No. 60/082,700 discloses all that the cited prior art discloses.

Consequently, based on the holdings of *In re Stempel* and *In re Moore*, Applicants respectfully submit that Komatsoulis *et al.* is not prior art under 102(e) since its effective priority date is after the invention by the Applicants for patent. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of Claims 78-84 under 35 U.S.C. §102(e).

CONCLUSION

In conclusion, the present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited. Should there be any further issues outstanding, the Examiner is invited to contact the undersigned attorney at the telephone number shown below.

Please charge any additional fees, including fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (referencing Attorney's Docket No. 39780-2630 P1C64).

Respectfully submitted,

Date: August 31, 2005

By: Barrie Greene
Barrie D. Greene (Reg. No. 46,740)

HELLER EHRMAN LLP
275 Middlefield Road
Menlo Park, California 94025-3506
Telephone: (650) 324-7000
Facsimile: (650) 324-0638

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